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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,757	03/09/2001	Jorg Leukel	CL/V-31346A	8263

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EXAMINER

BERMAN, SUSAN W

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/802,757	Applicant(s) LEUKEL ET AL.	
	Examiner Susan W Berman	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02-10-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1711

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-8, and the species corresponding to Example 3 and set forth in pages 1-2 in Paper No. 7 is acknowledged.

Claims 9-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7.

Specification

The disclosure is objected to because of the following informalities: the Examiner has not found any disclosure of what is meant by "triggerable precursor". In what manner is the precursor "triggerable"?

Appropriate correction is required.

Claim 1 is objected to because of the following informalities: the phrase "group which functions as a triggerable precursor for carbene or nitrene formation" is used to define "Z" in formula (1), however, the examiner has not found any definition of the term "triggerable" used in the definition of "Z", therefore, it is not clear what the meaning of a "triggerable precursor..." is. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 5-8 define the group "Z" in formula (1) as a "triggerable precursor for carbene or nitrene formation". The group "Z" is not clearly defined because the meaning of the word "triggerable" is not defined within the specification or claim, therefore, it is not clear what kind of group functions as a "triggerable precursor...". In what manner, or how, or by what, is the precursor "triggerable" to form a

Art Unit: 1711

nitrene or carbene? Claim 6 fails to use proper Markush terminology, i.e. "is selected from the group consisting of ...and...". See line 2.

Allowable Subject Matter

Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 2-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The following references are cited as being relevant prior art. However, none of the prior art references teaches compounds of formula (1) set forth in instant claim 1.

Westling et al (5,700,921) disclose reagents and methods for labeling nucleic acids. Oligomeric compounds containing an azido group and an electron withdrawing group on a phenylene ring are disclosed. See Figure 1. The compounds are prepared from a nucleic acid tagged with an aryl azide containing a protected thiol. The compounds differ from the instantly claimed compounds by not containing the linking group "A" or (oligomer) as defined in instantly claimed formula (1) in claim 1.

Chabreck et al (6,447,920) disclose ethylenically unsaturated hydrophilic macromonomers for obtaining a hydrophilic surface coating on a surface provided with initiator radicals. See formulas (1) and (2). The disclosed formulas differ from the instantly claimed formula (1) because the ethylenically unsaturated group is not bonded to "-A- (oligomer)" through a phenylene group.

Chabreck et al (4,468,667) disclose ophthalmic moldings comprising an organic bulk material having covalently bonded to the surface saccharide acceptors to which carbohydrates are enzymatically attached. See formula (1) in columns 4-5, formula (5) in columns 9-11, formula (9) in columns 12-14 and 20.

Art Unit: 1711

Chabreck et al (6,521,352) disclose a process for coating a material surface employing a hydrophilic telomer of formula (oligomer)-T. See column 1, lines 40-67.

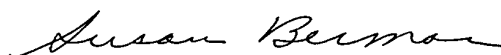
Lohmann et al [2002/0172831] disclose comb-type polymers comprising side chains carrying a triggerable precursor for carbene and nitrene formation. See claim 4, wherein "Q" is a triggerable precursor for carbene or nitrene formation. The difference between the disclosed formula and the instantly claimed formula appears to be that the triggerable precursor is bonded to the oligomer rather than to the group "A" in the formula.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
April 19, 2003